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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,789	08/29/2001	Setsuo Arita	A8319.0006/P006	4620

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DICKSTEIN SHAPIRO LLP  
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Washington, DC 20006-5403

EXAMINER
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CHOWDHURY, SUMAIYA A

ART UNIT	PAPER NUMBER
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2421

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12/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/940,789	<b>Applicant(s)</b> ARITA ET AL.	
	<b>Examiner</b> SUMAIYA A. CHOWDHURY	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-22,31,32,42 and 59-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-22,31,32,42 and 59-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/08 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 20-22, 31-32, 42, and 59-64 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 42 and 64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 42 and 64 recite "A program for use in an information supply terminal...". However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized"). The examiner suggests

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amending the claim to embody the program on computer-readable medium or equivalent in order to make the claim statutory. For example, the preamble of claim 42 should read --**A computer readable medium encoded with computer executable instructions that when executed by the computer result in:** --. Further, note that any amendment to the claim should be commensurate with its corresponding disclosure.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20-22, 31-32, 42, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (6177931) in view of Kamada, Matheny, Ellis (7185355) and Ismail (6614987).

As for claim 20, Alexander teaches an information service system comprising:

a service processing center for receiving marketing information via a network (col. 33, lines 9-15, col. 29, lines 14-20);

a first information supply terminal connected to the network and configured to identify at least one individual person (col. 28, lines 22-29) and to automatically output marketing information for the individual person to the service

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processing center (col. 33, lines 9-15), the information supply terminal comprising:

an information managing portion (RAM) comprising:

an individual audience result information portion (viewer profile information) configured to generate individual audience result information based on a media program/programs watched by the individual person (col. 28, lines 30-52, col. 29, lines 14-67); and

a media program category storage portion (RAM) having media programs classified into categories in advance for generating the individual interest information (col. 33, lines 49-60); and

an individual interest information portion (viewer profile analysis program) configured to automatically generate individual interest information comprising at least one program category (theme; e.g. comedy, sports, drama, movie, sitcom, science fiction, adventure, mystery, etc.) based on the individual audience result information of the classified categories stored in the media program category storage portion (col. 29, lines 44-50);

a computer-readable storage medium (RAM) configured to store a file, wherein the file stores the individual audience result information (col. 29, lines 14-67),

wherein the marketing information comprises the individual interest information (col. 29, lines 14-21).

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Wherein individual persons watch media programs by media program receivers, and the individual interest information is converted by a signal conversion means into a signal which can be displayed on a monitor of the media program receiver (col. 31, lines 27-31).

Wherein the individual interest information of an individual person is generated based on individual audience result information of the individual person with reference to a media program category storage portion classified into categories in advance (col. 28, lines 30-52, col. 29, lines 14-67).

The individual interest information is used as marketing information representing a category in which each of the individual person is interested (col. 33, lines 9-15, lines 49-60, col. 29, lines 44-50); and

Generating individual interest information further comprises representing a category of programs watched by each of the individual person (col. 29, lines 44-50).

The individual interest information is used as marketing information in order to offer service beneficial to each of the individual persons (col. 33, lines 9-15).

The categories are classified into a television program category table (col. 29, lines 44-50, col. 33, lines 48-60).

Wherein the individual audience result information portion adds, to the individual audience result information, information representing that a media program was watched by the individual person (col. 28, lines 30-38)

However, Alexander fails to teach:

audience information is stored when a program is kept on for at least a predetermined time;

wherein at least one point is awarded to the individual person when the individual audience result information is stored in the file;

a signal conversion portion for converting the individual interest information into a video signal representing the individual interest information which can be displayed on a monitor of a media program receiver by which the individual person can watch a desired media program voluntarily when the individual person selects a channel, thereby to display the individual interest information on the monitor;

wherein the information supply terminal retrieves the media program category portion based on the media program associated with the information representing that the media program was watched by the individual person thereby to add a numerical value to a hit category of the individual information.

In an analogous art, Kamada teaches that a record is created for a program that is viewed for more than a predetermined time in order to prevent an extremely short-time view from being registered as a record, which occurs in "channel shopping" - col. 6, lines 59-66.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Alexander's invention to include the above mentioned limitation, as taught by Kamada, for the advantage of solely recording information about the programming the user actually did watch rather than additionally storing channels the user just flipped through, thereby conserving memory.

Although Alexander teaches providing an award to the user (col. 29, lines 1-7), Alexander and Kamada fail to teach:

wherein at least one point is awarded to the individual person when the individual audience result information is stored in the file;

a signal conversion portion for converting the individual interest information into a video signal representing the individual interest information which can be displayed on a monitor of a media program receiver by which the individual person can watch a desired media program voluntarily when the individual person selects a channel, thereby to display the individual interest information on the monitor;

In an analogous art, Matheny teaches:

wherein at least one point is awarded to the individual person when the individual audience result information is stored in the file (col. 3, lines 6-14, lines 50-67, col. 4, lines 7-14);

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Alexander and Kamada's invention to include the above mentioned limitation, as taught by Matheny, for the advantage of encouraging viewers to pay attention to programming.

However, Alexander, Kamada, and Matheny fail to teach:

a signal conversion portion for converting the individual interest information into a video signal representing the individual interest information which can be displayed on a monitor of a media program receiver by which the individual person can watch a desired



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media program voluntarily when the individual person selects a channel, thereby to display the individual interest information on the monitor;

wherein the information supply terminal retrieves the media program category portion based on the media program associated with the information representing that the media program was watched by the individual person thereby to add a numerical value to a hit category of the individual information.

In an analogous art, Ellis teaches the user can view their profile on their television screen (Fig. 7, 12, 13, 31, col. 8, lines 47-67, col. 9, lines 5-15, col. 10, lines 18-55).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Alexander, Kamada, and Matheny's invention to include the above mentioned limitation, as taught by Ellis, for the advantage of allowing the user to modify their profile.

However, Alexander, Kamada, Matheny, and Ellis fails to disclose:

wherein the information supply terminal retrieves the media program category portion based on the media program associated with the information representing that the media program was watched by the individual person thereby to add a numerical value to a hit category of the individual information.

In an analogous art, Ismail discloses:

wherein the receiver retrieves the media program category portion based on the program associated with the information representing that the program was watched by

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the individual person thereby to add a numerical value to a hit category of the individual information (col. 12, lines 44-65, col. 3, line 45 – col. 4, line 20).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Alexander, Kamada, Matheny, and Ellis' invention to include the above mentioned limitation, as taught by Ismail, for the advantage of providing a method in which a user's preferences are determined/displayed numerically.

Claim 21 contain the limitations of claim 20 and is analyzed as previously discussed with respect to that claim. Claim 21 additionally discloses the following which Alexander teaches:

- an information service system comprising:

- a service processing center (advertisers, head end operators, guide producers) configured to receive the marketing information from the at least one information supply terminal via a network (col. 33, lines 9-15, col. 29, lines 14-20), the service processing center comprising:

- a computer-readable storage medium (storage means at head end operator) configured to store a file, wherein the file stores individual audience result information (col. 33, lines 9-15, col. 29, lines 14-20)

- an information managing portion comprising:

- an individual audience result information portion (component at head end operator) configured to receive the individual audience result

information generated based on a media program/programs watched by the individual person (col. 28, lines 30-52, col. 29, lines 14-67); and an individual interest information portion (component at head end operator) configured to receive automatically generated individual interest information comprising at least one program category based on the individual audience result information (col. 29, lines 44-50).

Claim 22 contains the limitations of claims 20 and 21 and is analyzed as previously discussed with respect to those claims. Claim 22 additionally calls for the following:

A file managing means (component at head end operator) for managing a file of at least said individual interest information (col. 29, lines 44-50).

a personal data input means for inputting, as personal data, information about a media program/programs watched by each of said individual persons, from corresponding one of said information supply terminals (Alexander; col. 29, lines 14-30);

an audience result information aggregating means for aggregating said inputted individual audience result information (Alexander; col. 29, line 50-col. 30, line 45);

Alexander teaches said system has a configuration so that said individual interest information is generated on the basis of said individual audience result information by searching a media program category storage means in which a category of each media program is stored in association with said media program (Alexander; Referring to fig. 7,

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the user can search the epg by categories. Referring to col. 29, lines 30-55, the viewer profile is developed based on interactions with the epg.)

a second point-awarding means for awarding a predetermined point/points to said individual person correspondingly to contents of said inputted personal data (Matheny [5, 50-63]).

Claim 31 contains the limitation of claim 20 and is analyzed as previously discussed with respect to that claim. Claim 31 additionally calls for the following:

a channel selection information input device (remote controller 26 – fig. 2) for inputting channel selection information through a media program receiver by which said individual person can watch a desired media program voluntarily when said individual person selects a channel (col. 3, lines 20-55);

an information generator for generating individual audience result information on the basis of an individual identification result and said channel selection information and for automatically generating individual interest information on the basis of said individual audience result information (col. 28, lines 30-52, col. 29, lines 14-67);

Claim 32 contains the limitations of claims 20, 22, and 31 and is analyzed as discussed with respect to those claims.

Claim 42 contains the limitations of claims 20, 21 and 31 and is analyzed as previously discussed with respect to those claims.

As for claims 59-64, Ismail discloses wherein the individual audience result information includes information representing a time or time period during which the media program was watched by the individual person, and the information supply terminal adds the numerical value corresponding to the watched time or time period to the hit category of the individual information (col. 3, line 44 – col. 4, line 20).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUMAIYA A. CHOWDHURY whose telephone number is (571)272-8567. The examiner can normally be reached on Mon-Fri, 9-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sumaiya A Chowdhury/  
Examiner, Art Unit 2421

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421